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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/601,017	06/20/2003	Takamichi Naito	11333/23	7116

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Tadashi Horie
Brinks Hofer Gilson & Lione
NBC Tower, Suite 3600
P.O. Box 10395
Chicago, IL 60610

EXAMINER

RAMILLANO, LORE JANET

ART UNIT	PAPER NUMBER
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1743

DATE MAILED: 09/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/601,017

Applicant(s)

NAITO ET AL.

Examiner

Lore Ramillano

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 June 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) 1-8 and 21-26 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 9-20 and 27-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-31 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 June 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 6/20/03.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-8, drawn to an analyzer for analyzing analyte operable under a plurality of operation modes, classified in class 422, subclass 63.
 - II. Claims 9-20 and 27-31, drawn to an analyzer, classified in class 700, subclass 17.
 - III. Claims 21-26, drawn to an analyzer comprising an assay mechanism; a touch panel display; a controller; and a body, classified in class 422, subclass 67.

The inventions are distinct, each from the other because of the following reasons:

Inventions of Groups I and II; and Groups III and II are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination of Group I and Group III as claimed do not require the particulars of the subcombination as claimed because both Group I and Group III do not require the claimed display of Group II. The subcombination has separate utility such as, an analyzer that does not require a memory for storing a plurality of screens.

Inventions of Groups I and III are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct if they do not

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overlap in scope and are not obvious variants, and if it is shown that at least one subcombination is separately usable. In the instant case, subcombination Group III has separate utility such as, an analyzer that does not require a screen display means. See MPEP § 806.05(d).

2. Because these inventions are independent or distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

3. During a telephone conversation with Gregory H. Zayia on 8/17/06 a provisional election was made without traverse to prosecute the invention of Group II, claims 9-20 and 27-31. Affirmation of this election must be made by applicant in replying to this Office action. Claims 1-8 and 21-26 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

4. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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6. Claims 9-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 9-20 are indefinite because they claim "an analyzer" and yet there is no structure for an analyzer claim. Applicants' claims would be better directed to "a display for an analyzer".

Claim 9 is indefinite because of the language "display," "predetermined screen," and "link." Is applicant referring to a computer display? What does applicant mean by characterizing the screen as being "predetermined"? What does applicant mean by "link"? A hyperlink?

Furthermore, claim 9 is indefinite because it cannot be determined whether applicant intended the following terms -- "first screen," "second screen," "hierarchical menu," "main screen," "first link," and second link" -- to be considered as structural limitations of the analyzer since the "wherein" clause generally raises a question as to the limiting effect of the language, after the clause, in a claim.

Claim 12 is indefinite because the claim does not appear to structurally further limit claim 11. The limitations of claim 12 do not appear to show any structural connection to claim 11.

Claim 14 is indefinite because the claim language does not clearly indicate what applicant is claiming. Is applicant claiming the "first screen" may be a "reagent replacement screen," a "status screen," or a "shutdown screen"? Or is applicant claiming that the analyzer further comprises a "reagent replacement screen," "status

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screen,” and “shutdown screen”? Also, what does applicant mean by claiming a “reagent replacement screen”? Is this a maintenance-related function?

Claim 15 is indefinite because the claim does not appear to structurally further limit claim 14. The limitations of claim 15 do not appear to show any structural connection to claim 11. Is the “function button” a function key that allows the operator to access one of the claimed screens recited in claim 14?

Claim 16 is indefinite because the claim language does not clearly indicate what applicant is claiming. Is applicant claiming the “second screen” may be a “quality control screen,” a “maintenance screen,” or a “setting screen”? Or is applicant claiming that the analyzer further comprises a “quality control screen,” “maintenance screen,” and “setting screen”?

Claim 17 is indefinite because the claim does not appear to structurally further limit claim 16. The limitations of claim 17 do not appear to show any structural connection to claim 16. Is the “function button” a function key that allows the operator to access one of the claimed screens recited in claim 16?

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States

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only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. **Claims 9-20 and 27-31** are rejected under 35 U.S.C. 102(b) as being anticipated by Emi et al. ("Emi," US 6137897).

Emi discloses an invention comprising: a display (column 4, lines 47-48); a controller (column 5, lines 5-6), wherein either the first screen or the second screen corresponds to a hierarchical menu (blood cell image filing system); and the main screen (i.e. NUMERICAL ENTRY screen to input the specimen number or access number) comprises a first link and a second link (DPS). (column 8, lines 64 to column 9, line 8).

Emi further discloses: a first screen, which is an analysis screen (display screen during the inspection work, Fig. 3); a second screen (display screen of the images of the past, Fig. 4); a link button (i.e. HISTORY OF PATIENT function key, Figs. 3 and 4) found in the first and second screen; a predetermined screen, which comprises a first area and a second area (screen that allows the operator to start the microscopy work, column 9, lines 15-18); a function button (i.e. NEXT function key, Fig. 4); a jump button (i.e. SAVE & NEXT function key, Fig. 3); an assay mechanism (microscopy performed by the microscope, 4, Fig. 1); a body (4, Fig. 1); and a touch panel display (column 9, lines 48-57).

9. **Claims 9, 13 and 19-20** are rejected under 35 U.S.C. 102(e) as being anticipated by Mishima et al. ("Mishima," US 6391263).

The applied reference has a common assignee, Sysmex Corporation, with the instant application. Based upon the earlier effective U.S. filing date of the reference, it

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constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Mishima discloses an analyzer comprising: a display (Fig. 1A); and a controller (Fig. 1A), wherein either the first screen (analysis screen, Fig. 7) or the second screen corresponds to a hierarchical menu (animal type table, Fig. 6); and the main screen comprises a first link and a second link (column 7, line 60 to column 8, line 12).

Mishima further discloses an assay mechanism (sample assayer, column 4, lines 25-38); and a body (Fig. 1A).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lore Ramillano whose telephone number is (571) 272-7420. The examiner can normally be reached on Mon. to Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on (571) 272-1267. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.


Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

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Lore Ramillano
Examiner
Art Unit 1743

8/22/06


Jill Warden
Supervisory Patent Examiner
Technology Center 1700